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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,511	10/06/2000	Raymond Andersen	P108281-0000	6795

7590 03/16/2007

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EXAMINER	
LUKTON, DAVID	
ART UNIT	**PAPER NUMBER**
1654	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/581,511	ANDERSEN ET AL.	
	Examiner	Art Unit	
	David Lukton	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-25,27,29,31-66 and 68-78* is/are pending in the application.

4a) Of the above claim(s) *24,27,29,34,36,59,60,62 and 74* is/are withdrawn from consideration.

5)☒ Claim(s) *51,58,61,63-66,71,72 and 76* is/are allowed.

6)☒ Claim(s) *23,25,31,35,37-47,53,54,68-70,73,75,77 and 78* is/are rejected.

7)☒ Claim(s) *32,33,48-50,52 and 55-57* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Pursuant to the directives of the amendment filed 12/19/06, several claims have been amended. Claims 23-25, 27, 29, 31-66, 68-78 remain pending. Claim 74 remains withdrawn from consideration pursuant to the original restriction. Claims 24, 27, 29, 34, 36, 59, 60, 62 are withdrawn from consideration, since they do not encompass the elected specie. The following claims are examined in this Office action: 23, 25, 31-33, 35, 37-58, 61, 63-66, 68-73, 75-78.

Applicants' arguments filed 9/14/05 have been considered and found persuasive in part. For purposes of this Office action, the characterization of "allowable" is applied to each of the following claims: 51, 58, 61, 63-66, 71, 72, 76. The following claims are objected to because of their dependence on rejected claims: 32, 33, 48-50, 52, 55-57.

Applicants' arguments filed 1/5/07 have been considered and found persuasive in part. The rejection of claims 31-33 & 76 as anticipated by Johnson (WO 97/04004) is withdrawn. Also withdrawn is the rejection of claims 75, 77, 78 as anticipated by Eisenbach-Schwartz ('939).

✦

Claims 35, 37, 38-43, 45 46, 54 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 limits R_1 and R_2 to hydrogen, alkyl or acetyl. In the fourth line of text following the structure, the following is recited:

"for whichever of R_1 or R_2 is R or ArR...".

However, this is inconsistent with the previous definition of these variables. The same situation applies in the case of claims 37 & 38.

✧

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

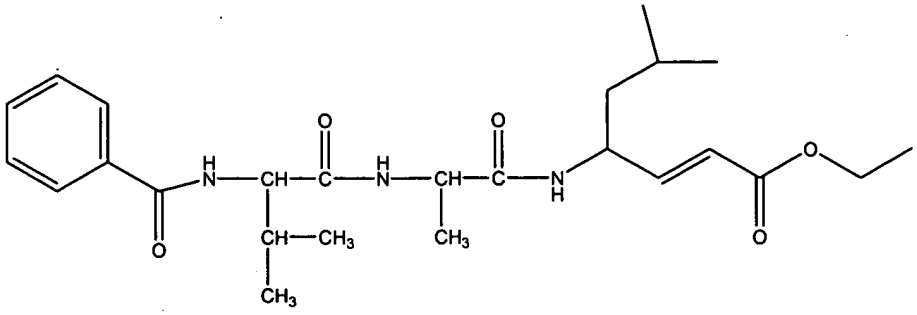
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23, 25, 44, 47, 53, 68-70, 73, 75 are rejected under 35 U.S.C. §102(a) as being anticipated by Johnson (WO 97/04004).

As indicated previously, Johnson discloses compound 26 (page 74), which has the following structure:



This compound is encompassed by the claims when the substituent variables are as follows:

R1 = benzoyl;
R2 = hydrogen;
R3 = methyl;
R4 = methyl;
R5 = hydrogen;
R6 = hydrogen
R7 = methyl
R8 = hydrogen
Y = propylene substituted with isobutyl
Z = -O-CH_2-CH_3

In response, applicants have pointed to the following phrase:

> "...provided that if either one of R_1 and R_2 is hydrogen, each of R_3, R_4, R_6 and R_8 is hydrogen and R_5 is isopropyl or phenyl and R_7 is methyl or benzyl then ... R is limited to..."

Applicants have argued that within this phrase, one should disregard everything that comes after the second rendition of "hydrogen". However, this interpretation is entirely unrealistic, and would be seen as such even by a person having no scientific training.

The rejection is maintained.

✧

Claim 23, 25, 31, 44, 47, 53, 68-70, 73, 75 rejected under 35 U.S.C. §102(b) as being anticipated by Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995).

As indicated previously, Falender discloses the following compound on page 134 ("Ag" represents allylglycine):

Ag-Phe-Phe-Ag-OEt

The disclosed compound is encompassed by the claims when the substituent variables are as follows:

R1 = allylglycine;
R2 = hydrogen;
R3 = phenyl;
R4 = hydrogen;
R5 = hydrogen;
R6 = hydrogen;
R7 = benzyl;
R8 = hydrogen;
Y = butene;
Z = $-O-CH_2-CH_3$

In response, applicants have pointed to the following phrase:

> "...provided that if either one of R_1 and R_2 is hydrogen, each of R_3, R_4, R_6 and R_8 is hydrogen and R_5 is isopropyl or phenyl and R_7 is methyl or benzyl then ... R is limited to..."

Applicants have argued that within this phrase, one should disregard everything that comes

after the second rendition of "hydrogen". However, this interpretation is unreasonable, and would be seen as such even by a person having no scientific training.

The rejection is maintained.

✦

The following is a quotation of 35 USC. §103 which forms the basis for all obviousness rejections set forth in the Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 23, 25, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Johnson (WO 97/04004).

The teachings of Johnson are indicated above, and previously. Applicants may choose to argue, in response to this rejection, that the compound disclosed by the reference is excluded by virtue of the provisos in the claims. In the event that applicants were to make such an

argument, the response (by the examiner) would be that because of "obvious variants", justification for a §103 rejection exists. Consider again the compound above for which the substituent variables are as follows:

R1 = benzoyl;
R2 = hydrogen;
R3 = methyl;
R4 = methyl;
R5 = hydrogen;
R6 = hydrogen
R7 = methyl
R8 = hydrogen
Y = propylene substituted with isobutyl
Z = $-O-CH_2-CH_3$

Applicants may choose to argue that, somehow, this particular compound is excluded. Even if this is true, there are other compounds that would not be excluded. For example, the compound in which R3 is ethyl would not be. Or the compound in which R7 is ethyl. [*In re Shetty* (**195** USPQ 753); *In re Hass & Susie* (**60** USPQ 544)]. Thus, the claims are rendered obvious.

✧

Claims 23, 25, 31, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995). As indicated previously, Falender discloses the following compound on page 134 ("Ag" represents allylglycine):

Ag-Phe-Phe-Ag-OEt

The disclosed compound is encompassed by the claims when the substituent variables are as follows:

R1 = allylglycine;
R2 = hydrogen;
R3 = phenyl;
R4 = hydrogen;
R5 = hydrogen;
R6 = hydrogen;
R7 = benzyl;
R8 = hydrogen;
Y = butene;
Z = $-O-CH_2-CH_3$

Applicants may choose to argue that, somehow, this particular compound is excluded. Even if this is true, there are other compounds that would not be excluded. For example, the compound in which R_3, taken together with the carbon atom to which it is bonded, represents phenylethyl (rather than benzyl). Or the compound in which R_7 is phenylethyl. Thus, even it is true that the §102 rejection above is not valid (and the point is not conceded), this ground of rejection is valid. [*In re Shetty* (**195** USPQ 753); *In re Hass & Susie* (**60** USPQ 544)]. Thus, the claims are rendered obvious.

✧

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional

month upon filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

D. Lukton

DAVID LUKTON, PH.D.
PRIMARY EXAMINER